

Attorney Docket No. 55411.000002
Application No.: 09/242,657

REMARKS

A. Status of Claims

Claims 17 and 18 are cancelled without prejudice or disclaimer to the subject matter therein. Claims 16 and 22 are indicated as allowed. Claims 1-15, 21, 23, 25 and 27 are withdrawn. Claims 1-4, 6-11, 13-16, 21-23, 25 and 27 are pending.

B. Claim Amendments and Rejections

In the Office Action, the Examiner reopened prosecution to change the designation of claim 17 from allowed to rejected while also changing the objection of claim 18 to a rejection. The Examiner asserts that claims 17 and 18 do not comply with the written description requirement of 35 U.S.C. § 112, first paragraph, based on the recitation of the phrase "each step changing the promoter activity by 50%-100%." Office Action, page 2.

Applicants respectfully submit that the phrase in question is supported by the written description of the application when the correct standard is applied. In particular, the claims are directed to a method involving the preparation of a set of promoters wherein the promoters are selected in small step-wise increments based on promoter activity. The Examiner incorrectly premises the rejection on the allegation that the claims encompass an enormous genus of promoter sets. Contrary to the Examiner's assertion, as the claims are directed to a method they simply do not encompass the genus of promoter sets suggested by the Examiner. A claim to a method is not a claim to every possible product produced by that method. Likewise, an application need not disclose the structure of every possible product that can produced by a claimed method. In fact, the broad applicability of Applicants novel method is part of its usefulness. Indeed, the present application provides more than sufficient examples and disclosure such that a person of ordinary skill in the art would recognize that Applicants had possession of the subject matter of claim 17 and 18 at the time the application was filed. For instance, the relevant aspect of the claimed method is clearly explained on page 21 at lines 9-24 and illustrated in Figure 1.

Attorney Docket No. 55411.000002
Application No.: 09/242,657

Although Applicants believe that the application provides adequate written description for the phrase in question, Applicants have cancelled claims 17 and 18, without prejudice or disclaimer to the subject matter therein, to advance the prosecution of the present application. Applicants reserve all their rights to pursue the subject matter of these claims in a subsequent application.

REQUEST FOR ALLOWANCE

For at least the reasons detailed above, Applicants respectively submit that all of the claims in the application are patentable. Favorable consideration, entry of this amendment, and issuance of a notice of allowance are respectively requested.

In the event any issues remain, the Examiner is encouraged to contact Applicants' representatives to resolve such issues in an expeditious manner, and place the application in condition for allowance.

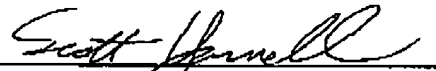
It is believed that no additional fees are necessary. However, in the event that any fees are necessary, the Director is hereby authorized to charge such fees or credit overpayment to our Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS

Date: April 24, 2006

By:



Stanislaus Aksman
Registration No. 28,562
Scott F. Yamell
Registration No. 45,245

1900 K Street, N.W., Suite 1200
Washington, D.C. 20006-1109
Ph. (202) 955-1500
Fax (202) 778-2201

SFY/dkt